

### **REMARKS**

Claims 1- 10 were pending in this case. Upon entry of this Amendment, Claims 1 and 5 will be cancelled, and Claim 11 will be newly added, thus Claims 2-4, and 6-11 will be pending in this case.

The Office Action restricts alleging that the inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The Office Action offers Groups I through IV for selection, with each group comprising Claims 1-10 but directed to a separate moiety for Z, and as applicants read the Office Action, it is merely setting the pattern for selecting Z moieties. If applicants follow the Office Action, it is restricting each Z moiety into a separate group, for a total of Groups I through XXXV.

Applicants respectfully assert that it is untenable for the Office Action to divide the present case into 35 separate cases! Therefore Applicants strongly but respectfully traverse this restriction requirement.

Applicants will provide reasons for the traversal below, but to ensure a full response to the Office Action in the event that the restriction requirement is not withdrawn or modified by the Examiner, Applicants elect Claims 1-10 as limited to the moiety Z as set forth in Claim 4. If a particular species is required to be elected, Applicants hereby elect the species set forth in Example III-3 in the specification.

With this Amendment, applicants have cancelled Claim 1 and have provided Claim 2 as the new main claim in the case. Radical "A" has been defined to exclude the single bond. The definition of radical Q is amended to exclude sulfur. These amendments are not in derogation of art, and have been made simply to remove issues from this case and advance its prosecution.

Applicants respectfully remind the Examiner of the case of *Caterpillar vs. Commissioner of Patents*, 231 U.S.P.Q. 590 (E.D. Va. 1986) which brought the Patent Office to task when the PTO's interpretation of 37 C.F.R. Section 1.141(b)(2) as applied to unity of invention determinations in international applications, as the PTO's interpretation was not in accordance with the Patent Cooperation Treaty. In particular, acting as the International Searching Authority, the PTO in the *Caterpillar* case found a lack of unity where unity in fact existed. The court reminded the PTO that when the Office considers international applications as an International Searching Authority, as an International Preliminary Examining Authority and/or Mo6595

during the national stage as a Designated or Elected Office under 35 U.S.C. Section 371, PCT Rules 13.1 and 13.2 are to be followed when considering unity of invention of claims of different categories without regard to practice in national applications filed under 35 U.S.C. Section 111.

With regard to lack of unity issues, 37 C.F.R. Section 1.499 provides that if an Examiner finds that a national stage lacks unity of invention as set forth in 37 C.F.R. 1.475, the Examiner may require restriction. 37 C.F.R. Section 1.499 also provides that review of any such requirement is provided under 37 C.F.R. Section 1.143 (request for reconsideration) and 1.144 (petition to the Commissioner, noting that a petition will not be considered if reconsideration of the requirement was not requested). Therefore, pursuant to 37 C.F.R. Section 1.143, Applicants hereby request reconsideration of the requirement for restriction.

Applicants note that 37 C.F.R. 1.476 gives the International Searching Authority authorization to make this same determination with regard to unity of invention, and Applicants respectfully but earnestly point out that the International Searching Authority in this case made no objection alleging a lack of unity in this case.

Applicants respectfully assert that it would not be unduly burdensome for the Examiner to search each of the Z moieties in this single case due to the similar structural analogy between the compounds, and respectfully assert that this is actually one of the easier cases to search as a single application.

The PCT Administrative Instructions explicitly state at page AI-37 that with regard to Markush practice, the fact that the alternatives of a Markush grouping can be differently classified shall not, taken alone, be justification for a finding of a lack of unity of invention. This concept is supported in section (i) on page AI-38 of the PCT Administrative Instructions set forth in the MPEP, in the context of intermediate/final products where it is stated that Rule 13.3 requires that the determination of the existence of unity of invention be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim. Section (j) provides further clarification in that the determination of unity of invention remains the same regardless of the form of the claim used.

37 C.F.R. Section 1.475 and MPEP Section 1893.03(d) provide that a group of inventions is considered linked to form a single general inventive concept where

Mo6595

there is a technical relationship among the inventions that involves at least one corresponding special technical feature. 37 C.F.R. Section 1.475 provides, and MPEP Section 1890.03(d) repeats, that the expression “special technical feature” is defined as “meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art.”

Further, Annex B Part 2 of the PCT Administrative Instructions, as amended July 1, 1992 in Section 206 (appended at AI to the MPEP and cited in MPEP Section 1893.03(d)) provides:

“The determination by the International Searching Authority, the International Preliminary Examining Authority, **and the designated and elected Offices**, whether an international application complies with the requirement of unity of invention under Rule 13 shall be made in accordance with Annex B.”

Emphasis added.

Applicants again point out for emphasis that both the ISA and the International Preliminary Examining Authority have already made this same determination, a factor which should be given great weight here. Still further, in a corresponding pending European Patent Application both unity and, thereby inferentially, a lack of undue burden on the Examiner has been found where the present Claim 2 with all the Z moieties was examined in its entirety in the one single case without restriction!

Annex B Part 2 of the PCT Administrative Instructions provides 30 examples concerning unity of invention, with Examples 18-24 providing examples **specifically directed** to Markush practice. In Example 18, an indolyl moiety provides the significant structural element shared by all alternatives and since all the claimed compounds in Example 18 were alleged to possess the same utility (namely as a pharmaceutical for the purpose of enhancing the capacity of the blood to absorb oxygen) – unity was deemed to be present. Example 20 provides an example of a six-atom **heterocyclic** compound where the compound could include as element “Z” in its six atom ring “oxygen or sulfur” – where unity of invention was deemed to be present. Ironically, the Examiner in the instant case is also objecting to a heterocyclic moiety of radical Z as destroying unity of invention, where Example 20 found unity of invention to be present where a heterocyclic moiety was involved.

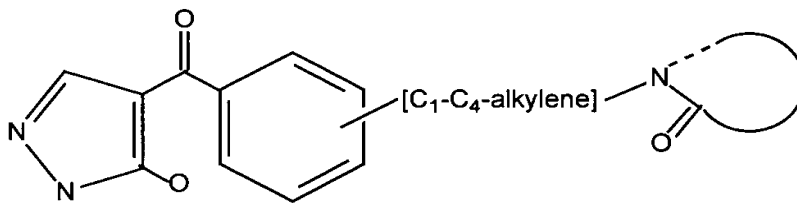
In the present case, all alternatives of the formula (I) have a common activity, namely their herbicidal activity.

In light of the ISA's and IPEA's determinations in this matter, and the examples of Annex B, the common herbicidal activity, and the fact that this search would **not** be unduly burdensome for the Examiner (as for example, the corresponding EP application where Claim 2 was examined for all Z moieties), for all these reasons Applicants believe there is more than adequate support for the lack of unity objection to be withdrawn. However, as additional support Applicants point out to the Examiner, that there is in fact the same common structure here as is exemplified in the examples of Annex B Part 2 of the PCT Administrative Instructions.

The significant structural element shared by all of the alternatives is that the claimed compounds contain a 4-carboxyphenyl-1,2-diazole group substituted by -A-Z wherein:

- A represents alkylene having 1-4 carbon atoms and
- Z represents a heterocyclic grouping which is bound via a nitrogen atom which has a carbonyl grouping in the alpha-position to said nitrogen.

The grouping -A-Z is the special technical feature that defines a contribution over the prior art and provides therefore, unity of invention. The significant structural element may be depicted as



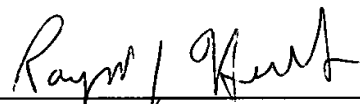
Applicants believe they are entitled to have Claim 2 considered in this single application for all of the foregoing reasons, but at the very least, Claim 11 should be easily considered in this single application due to the fact it is limited to three "Z" groups, the structural similarity between the groups, and the fact that this would present an extremely easy search for the Examiner to perform.

The compound of the present invention is certainly novel. For example, none  
Mo6595

of the documents cited in the IPER described compounds in which the radical A represents C1-C4-alkylene and the heterocycle Z possesses at least one carbonyl group, at least one nitrogen atom and said heterocycle being bound via a nitrogen atom to the radical A.

In light of the foregoing, reconsideration of the lack of unity objection, withdrawal of the same, and examination of all claims as amended by this Amendment in this one application is respectfully requested.

Respectfully submitted,

By   
Raymond J. Harmuth  
Attorney for Applicants  
Reg. No. 33,896

Bayer CropScienceLP  
100 Bayer Road  
Pittsburgh, Pennsylvania 15205-9741  
PHONE: (412) 777-8366  
FACSIMILE PHONE NUMBER:  
412-777-8363  
s/rmc/rjh/0108